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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,404	09/17/2001	Jiang Peng	42390P11100	1200
8791	7590	03/24/2004		
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			EXAMINER SHAPIRO, LEONID	
			ART UNIT	PAPER NUMBER

2673

DATE MAILED: 03/24/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,404

Applicant(s)

PENG, JIANG

Examiner

Leonid Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-4, 6, 12-13, 16, 19, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oueslati et al. (Pub. No.: US 2002/0105503 A1) in view of Makinwa et al. (US Patent No. 5,750,939).

As to claim 1, Oueslati et al. teaches a portable communication device (See Fig. 1, items 100,110, in description See Page 2, paragraphs 0018 - 0022) comprising: a display (See Fig. 1, items 100,113, in description See Page 2, paragraph 0018); and a detachable joystick; wherein the portable communication device is adapted to receive the detachable joystick, and the detachable joystick provides a user input indicated with a display (See Figs. 1,3,6, items 128,113,125, in description See Page 2, paragraph 0024).

Oueslati et al. does not show the detachable joystick is capable of being stored within the portable communication device when not in use.

Makinwa et al. teaches stylus is capable of being stored within the graphic tablet when not in use (See Fig. 6, items 102, 602, 604, See Col. 5, Lines 41-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Makinwa et al. approach of storing stylus in Oueslati et al. apparatus to store detachable

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joystick in order to store stylus in holder in the tablet in standby mode (See Col. 2, Lines 47-48 in the Makinwa et al. reference).

As to claim 12, Oueslati et al. teaches a method comprising; providing user input to a portable communication device using detachable joystick (See Figs. 1,3,6, items 128,113,125, in description See Page 2, paragraphs 0021 and 0024).

Oueslati et al. does not show the detachable joystick is capable of being stored within the portable communication device when not in use.

Ying teaches antenna is capable of being stored within the portable communication device when not in use (see Fig. 1, items 10,14, See Col. 2, Lines 65-67).

Makinwa et al. teaches stylus is capable of being stored within the graphic tablet when not in use (See Fig. 6, items 102, 602, 604, See Col. 5, Lines 41-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Makinwa et al. approach of storing stylus in Oueslati et al. apparatus to store detachable joystick in order to store stylus in holder in the tablet in standby mode (See Col. 2, Lines 47-48 in the Makinwa et al. reference).

As to claims 3,23 Oueslati et al. teaches the portable communication device is further adapted to store the detachable joystick when not in use as part of stylus (See Fig. 2, items 230,200, in description See Page 2, paragraph 0025).

As to claims 4,13, Oueslati et al. teaches the detachable joystick is adapted to indicate desired movement of a cursor on the display (See Figs. 1,3, items 113,125,230, in description See Page 2, paragraphs 0021-0022).

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As to claim 6, Oueslati et al. teaches motion sensors to sense movement of the detachable joystick (See Figs. 1,3,6, items 100,125,128,230, in description See Page 2, paragraphs 0021,0025).

As to claims 16,19, Oueslati et al. teaches inserting and removing the detachable joystick into the portable communication device (See Figs. 1-5, items 230,128, in description See Page 2, paragraphs 0024-0026).

2. Claims 2, 7-8, 17-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oueslati et al. and Makinwa et al. as aforementioned in claims 1, 14, 16 and 19 in view Hoggarth (Pub. No.: US 2002/0057257 A1).

As to claim 2, Oueslati et al. and Makinwa et al. do not show the detachable joystick comprises a user depressible button.

Hoggarth teaches the detachable joystick comprises a user depressible button (See Fig. 4, item 80, in description See Page 3, paragraph 0033).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Oueslati et al. and Makinwa et al. apparatus in order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

As to claims 7-8, 17, 20 Oueslati et al. and Makinwa et al. do not show an active operational mode of the portable communication device is initiated upon placement of the detachable joystick into portable communication device and an inactive operational mode of the

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portable communication device is initiated upon removal of the detachable joystick from portable communication device.

Hoggarth teaches the detachable joystick trigger closes the electrical circuit causing a signal to be relayed to the COM1 port (See Fig. 4, items 90,120,122, in description See Page 3, paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Oueslati et al. and Makinwa et al. apparatus to start an active operational mode of the portable communication device is initiated upon placement of the detachable joystick into portable communication device and an inactive operational mode of the portable communication device is initiated upon removal of the detachable joystick from portable communication device in order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

As to claim 18 Oueslati et al. and Makinwa et al. do not show initiating a cellular communication with the detachable joystick.

Hoggarth teaches the detachable joystick trigger closes the electrical circuit causing a signal to be relayed to the COM1 port (See Fig. 4, items 90,120,122, in description See Page 3, paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Oueslati et al. and Makinwa et al. + apparatus to initiating a cellular communication with the with the detachable joystick in order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oueslati et al. and Ying as aforementioned in claim 1 in view of Caravella.

Oueslati et al. and Makinwa et al. do not show the portable communication device is a cellular phone.

Caravella et al. teaches the portable communication device is a cellular phone (See Fig. 1, items 12,14,16, in description See Col. 2, Lines 10-11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a cellular phone as shown by Caravella et al. in Oueslati et al. and Makinwa et al. apparatus in to navigate through application software (See Page 1, paragraph 0002 in the Oueslati et al. reference).

4. Claim 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caravella et al. (US Patent No. 6,041,221) in view of Oueslati et al. and Ying.

Caravella et al. teaches an apparatus comprising: a processor (See Fig. 1, item 18, in description See Col. 1, Lines 9-19 and Col. 2, Lines 10-17); a static random access memory coupled to the processor (See Fig. 1, item 24, in description See Col. 1, Lines 9-19 and Col. 2, Lines 10-17); communication module to transmit a wireless communications (See Fig. 1, items 12,14,16, in description See Col. 1, Lines 9-19 and Col. 2, Lines 10-17).

Caravella et al. do not show a display and detachable joystick to provide a user input indicated with the display.

Oueslati et al. teaches display (See Fig. 1, items 100,113, in description See Page 2, paragraph 0018); and a detachable joystick to provides a user input indicated with a display (See

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Figs. 1,3,6, items 128,113,125, in description See Page 2, paragraph 0024). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Oueslati et al. display and detachable joystick in Caravella et al. apparatus in order to navigate through application software (See Page 1, paragraph 0002 in the Oueslati et al. reference).

Caravella et al. and Oueslati et al. do not show the detachable joystick is capable of being stored within the portable communication device when not in use.

Makinwa et al. teaches stylus is capable of being stored within the graphic tablet when not in use (See Fig. 6, items 102, 602, 604, See Col. 5, Lines 41-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Makinwa et al. approach of storing stylus in Caravella et al. and Oueslati et al. apparatus to store detachable joystick in order to store stylus in holder in the tablet in standby mode (See Col. 2, Lines 47-48 in the Makinwa et al. reference).

5. Claims 22, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caravella et al. and Oueslati et al. and Makinwa et al. as aforementioned in claim 21 in view Hoggarth.

As to claim 22 Caravella et al. and Oueslati et al. and Makinwa et al. do not show the detachable joystick comprises a user depressible button.

Hoggarth teaches the detachable joystick comprises a user depressible button (See Fig. 4, item 80, in description See Page 3, paragraph 0033).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Caravella et al. and Oueslati et al. and Makinwa et al. apparatus in

order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

As to claim 24 Caravel Caravella et al. and Oueslati et al. and Makinwa et al. do not show an active operational mode of the portable communication device is initiated upon placement of the detachable joystick into portable communication device and an inactive operational mode of the portable communication device is initiated upon removal of the detachable joystick from portable communication device.

Hoggarth teaches the detachable joystick trigger closes the electrical circuit causing a signal to be relayed to the COM1 port (See Fig. 4, items 90,120,122, in description See Page 3, paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Caravella et al. and Oueslati et al. and Makinwa et al. apparatus to start an active operational mode of the portable communication device is initiated upon placement of the detachable joystick into portable communication device and an inactive operational mode of the portable communication device is initiated upon removal of the detachable joystick from portable communication device in order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

6. Claims 5,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oueslati et al. and Makinwa et al. as aforementioned in claims 1, 13 in view Chan et al. (US Patent No. 6,346,938).

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Oueslati et al. and Makinwa et al. do not show the detachable joystick is adapted to select an icon on the display.

Chan et al. teaches pushing forward on the joystick moves user icon location (See Fig. 8, items 805-806, in description See Col. 11, Lines 4-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Chan et al. approach in Oueslati et al. and Makinwa et al. apparatus in order to navigate through application software (See Page 1, paragraph 0002 in the Oueslati et al. reference).

7. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Oueslati et al., Makinwa et al. and Chan et al. as aforementioned in claim 14 in view of Hoggarth.

Oueslati et al., Ying and Chan et al. do not show the detachable joystick comprises a user depressible button.

Hoggarth teaches the detachable joystick comprises a user depressible button (See Fig. 4, item 80, in description See Page 3, paragraph 0033).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Oueslati et al., Makinwa et al. and Chan et al. apparatus in order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

8. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oueslati et al. and Makinwa et al. as aforementioned in claims 1.

As to claim 9, Oueslati et al. and Makinwa et al. do not show detachable joystick comprises ink.

Oueslati et al. teaches a graspable portion a pen tip (See Fig. 2-3, items 128,230, in description See Page 2, paragraph 0025).

Since critically of usage of ink was not shown in specification or drawings, it would have been obvious to one of ordinary skill in the art at the time of the invention to assume that pen tip in Oueslati et al. and Makinwa et al. apparatus will contain ink. Therefore, the presence or absence of ink in the pen tip fails to patentably distinguish over the Oueslati et al. reference.

As to claim 10, Oueslati et al. and Makinwa et al. do not show the detachable joystick is adapted to indicate movement across the display on pixel-by-pixel basis.

Oueslati et al. teaches detachable joystick is adapted to indicate movement across the display (See Fig3, items 113, in description See Page 2, paragraph 0022).

Since critically of pixel-by-pixel not shown in specification or drawings, it would have been obvious to one of ordinary skill in the art at the time of the invention to assume that movement in Oueslati et al. and Makinwa et al. apparatus will be done on pixel-by-pixel basis or on group of pixels-by-group of pixels. Therefore, pixel-by-pixel movement fails to patentably distinguish over the Oueslati et al. reference.

9. Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caravella et al., Makinwa et al. and Oueslati et al. as aforementioned in claims 21.

Caravella et al., Makinwa et al. and Oueslati et al. do not show detachable joystick comprises ink.

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Oueslati et al. teaches a graspable portion a pen tip (See Fig. 2-3, items 128,230, in description See Page 2, paragraph 0025).

Since critically of usage of ink was not shown in specification or drawings, it would have been Caravella et al., Makinwa et al. and Oueslati et al. apparatus will contain ink. Therefore, the presence or absence of ink in the pen tip fails to patentably distinguish over the Oueslati et al. reference.

Response to Amendment

10. Applicant's arguments 01-15-04 with respect to claims 1-2, 3-25 have been considered but are moot in view of the new ground(s) of rejection.

Telephone inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonid Shapiro whose telephone number is 703-305-5661. The examiner can normally be reached on 8 a.m. to 5 p.m..

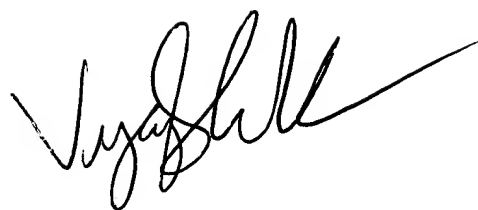
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on 703-305-4938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

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A handwritten signature in black ink, appearing to read 'Vijay Shankar', with a long horizontal stroke extending to the right.

**VIJAY SHANKAR
PRIMARY EXAMINER**